

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-31 are pending, with Claims 21-29 having been amended, and new Claims 30 and 31 having been added. The amendments to Claims 21-29 pertain to matters of form. Support for new Claims 30 and 31 is found, for example, in paragraphs [0039] and [0040] of the originally filed specification. Applicants respectfully submit that no new matter is added.

In the Official Action, Claims 1-6, 8, 9, 11-16, 18, 19, 21-25, 27, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shannon (U.S. Patent No. 6,233,618) in view of Kester (U.S. Patent No. 7,194,464), and further in view of Gusler (U.S. Patent No. 6,917,980); Claims 7, 17, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shannon, Kester and Gusler in view of Maurer et al. ("Hash Table Methods", hereinafter "Maurer"); and Claims 10, 20, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shannon, Kester and Gusler in view of Willens (U.S. Patent No. 5,889,958).

Applicants respectfully traverse the rejection of Claim 1 as obvious over Shannon, Kester, and Gusler. Claim 1 recites, *inter alia*,

(c) retrieving ***at the subscriber network*** digital information stored at a location corresponding to the location indicator and ***initially analysing content of information at said location*** for a predetermined maximum time in the event that the location indicator is not in the database and denying or fulfilling the request based on the initial analysis, wherein searching of the database and the initial content analysis occur at a network bridge installed at the subscriber network...[and]

(e) retrieving ***at the remote network node*** information stored at a location corresponding to the forwarded location indicator and ***further analysing a content type of the retrieved information***.

The outstanding Office Action has not established a *prima facie* case of obviousness because a person of ordinary skill in the art could not properly combine Shannon, Kester, and Gusler to arrive at the invention defined by Claim 1.

The invention defined by Claim 1 generally employs a collaborative filtering process, whereby filtering is performed at the subscriber network and at the remote network node. As noted by the language of Claim 1, the subscriber network and the remote node communicate with each other to collaborate on the filtering process. In other words, the invention defined by Claim 1 involves a decentralized filtering analysis.

The outstanding Office Action relies upon Shannon to disclose the claimed “initially analysing content” of step (c) and relies upon Kester to disclose the claimed “further analysing a content” of step (e). The Office appears to take the position that these references can be combined to equate to the claimed collaborative filtering described in Applicants’ Claim 1. However, Applicants respectfully traverse this position.

Shannon teaches away from a decentralized collaborative filtering technique. Shannon states, with respect to its filtering technique “[t]his is beneficial and overcomes the problems of the prior art content filtering systems since in this invention, the content filtering can be centralized at the network device.” Thus, Shannon teaches away from filtering being performed away from the network device. “A reference may be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). To this end, “disclosures in the references that diverge from and teach away from the invention cannot be disregarded,” Phillips Petroleum Company v. U.S. Steel Corp., 9 U.S.P.Q.2d 1461 (Fed. Cir. 1989). The above-noted passage from Shannon would

discourage a person of ordinary skill in the art from modifying the system of Shannon to have decentralized filtering analysis, wherein filtering is performed away from the network device.

Furthermore, any modification to change the system of Shannon to decentralize the filtering would render the system of Shannon unsatisfactory for its intended purpose. MPEP §2143.01(V) states “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” The purpose of Shannon, as noted above, is to have content filtering centralized at the network device to overcome problems of the prior art. Any modification to change this to a decentralized filtering process would render Shannon unsatisfactory for its intended purpose of “[overcoming] problems of the prior art content filtering systems since in this invention, the content filtering can be centralized at the network device.”¹

In light of the teachings of Shannon, Applicants respectfully submit that a person of ordinary skill in the art would be discouraged from modifying the system of Shannon based on the descriptions in Kester and Gusler. It is noted that page 4 of the Office Action justifies its obvious rationale by stating that a person of ordinary skill in the art would modify Shannon to “efficiently categorize content at a central facility.” It is noted that no support is provided for this subjective conclusion, and that this position is in contrast to the teachings of Shannon noted above.

In this regard, it is noted that substitution of an improper subjective conclusion as to knowledge in the art for concrete evidence of such knowledge relative to a core factual finding required for a determination of patentability is clearly improper. See In re Zurko, 59 USPQ2d 1693, 1697-98 (Fed. Cir. 2001) as follows:

¹ Shannon, col. 14, line 67 to col. 15, line 4.

Finally, the deficiencies of the cited references cannot be remedied by the [PTO's] general conclusions about what is "basic knowledge" or "common sense" to one of ordinary skill in the art....This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. As an administrative tribunal, the [PTO] clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the [PTO] cannot simply reach conclusions based on its own understanding or experience — or on its assessment of what would be basic knowledge or common sense. Rather, the [PTO] must point to some concrete evidence in the record in support of these findings. [Emphasis added.]

The even more recent Lee decision by the Federal Circuit Court of Appeals (In re Lee, 61 USPQ2d, 1430, 1435 (2002)) is again noted to emphasize the need for the PTO to provide actual evidence on the record, not mere unsupported opinion, as follows:

In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint [that of the person of ordinary skill in the art to which the subject matter pertains]. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. [Emphasis added.]

The Lee court further specifically found it to be erroneous and arbitrary conduct for the PTO to attempt to resolve questions material to patentability by reliance upon "subjective belief and unknown authority" (see In re Lee at 61 USPQ2d 1434) as is being done here. Also note the Kotzab court admonition (at 55 USPQ2d 1317) that "[b]road conclusory statements are not evidence."

In view of the above-noted deficiencies in the Office Action, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Accordingly, the outstanding rejection of Claim 1 cannot stand and must be withdrawn.

Accordingly, Applicants respectfully submit that Claim 1 (and any claims dependent thereon) patentably distinguish over Shannon, Kester, and Gusler, taken alone or in proper combination. Claims 11 and 21 recite elements analogous to those of Claim 1. Thus, Applicants respectfully submit that Claims 11 and 21 (and any claims dependent thereon) patentably distinguish over Shannon, Kester, and Gusler, taken alone or in proper combination, for at least the reasons stated for Claim 1.

Furthermore, Applicants respectfully submit that new Claims 30 and 31 further patentably distinguish over the cited references.

Claim 30 recites, *inter alia*, “(g) accessing the network bridge and customizing a level of filtering performed at the network bridge based on policies adopted at the subscriber network.” The outstanding Office Action relies upon Shannon to disclose the claimed “network bridge.” However, there is no disclosure or suggestion in Shannon of “accessing the network bridge and customizing a level of filtering performed at the network bridge based on policies adopted at the subscriber network.”

Claim 31 recites, *inter alia*,

comparing the location indicator to an exception list that includes a list of digital information allowed to be accessed by the network users of the at least one subscriber network; and

bypassing a filtering process of steps (b) through (f) if the location indicator is included in the exception list and proceeding to steps (b) through (f) if the location indicator is not included in the exception list.

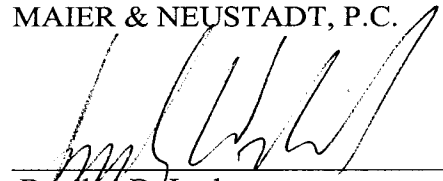
New Claim 31 recites elements similar to those of original Claim 8, but further describes the “exception list” and how it is used. Page 7 of the Office Action relies upon Shannon to disclose the “exception list.” However, Shannon does not disclose or suggest “an exception list that includes a list of digital information allowed to be accessed by the network

users of the at least one subscriber network” and bypassing or not bypassing the filtering dependent upon the “exception list” as described in Claim 31.

Accordingly, in view of the present amendment and in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

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